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| 09/470,580 | 12/22/1999 | STEVEN B. SOLOMON | 067251.0104 | 6336 |
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| BAKER & BOTTS LLP 2001 ROSS AVENUE DALLAS, TX 752012980 | | | MYHRE, JAMES W | |
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/470,580

Filing Date: December 22, 1999

Appellant(s): SOLOMON ET AL.

Kurt M. Pankratz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 13, 2004.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on September 23, 2004 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|--------------|---------|
| 5,791,991 | SMALL | 8-1998 |
| 6,330,544 | WALKER et al | 12-2001 |

6,039,244

FINSTERWALD

3-2000

(10) *Grounds of Rejection*

(a) Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 09/470,588. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications pertain to processing a rebate either as a cash rebate or as a credit voucher rebate. Both applications contain claims which are directed to processing the credit voucher during a subsequent purchase by the consumer using the same steps. Although the two applications contain slightly different terminology and/or semantics, the steps involved in each application to process the claimed rebates are the same. For example, Claim 31 of Application 09/470,588 is a method which includes the steps of Claims 1, 5, 6, and 31: (a) identifying a product bearing a rebate based on input received from a user; (b) receiving consumer information from the user, the consumer information identifying a purchase of a product; (c) communicating the consumer information to a remote rebate processing center using a communications network; (d) receiving rebate information from the remote rebate processing center using the communications network, the rebate information comprising a transaction identifier identifying the rebate for the product and the purchase of the product; (e) receiving at least two disbursement options for the user to receive the rebate; (f) receiving a selected one of the disbursement options from the user, wherein the disbursement options comprise a cash rebate or a credit voucher valid for purchases at a limited

scope of retail sites, wherein a cash value of the credit voucher is greater than the cash rebate; and (g) outputting a rebate request form comprising the transaction identifier, the transaction identifier for physical delivery to the remote rebate processing center.

Claim 31 of the present application is also a method which includes the steps of (a) receiving purchase information identifying a product bearing a rebate; (b) communicating the purchase information to a remote rebate processing center; (c) receiving rebate information describing the rebate from the remote rebate processing center, the rebate information comprising at least two disbursement option, a first one of the disbursement options having a first cash value to a recipient and a second one of the disbursement options having a second cash value to a recipient, the first cash value different than the second cash value; and (d) displaying the rebate information.

When examining the correspondence of the features in the two claims one finds that steps (a) and (b) of the '588 application equate to step (a) of the current application; step (c) of the '588 application corresponds to step (b) of the current application; steps (d)-(f) of the '588 application correspond to step (c) of the current application; and step (g) of the '588 application corresponds to step (d) of the current application.

Many of the other dependent claims in the current application have corresponding claims which include the exact same wording in the other application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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(b) Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (5,791,991) in view of Walker et al (6,330,544), and Finsterwald (6,039,244).

Claims 1, 11, 21, 25, and 31: Small discloses a method and apparatus for processing rebates, comprising:

- a. Displaying a plurality of product identifiers associated with products bearing a rebate (col 7, lines 52-54);
- b. Receiving purchase information from a user indicating purchase of one of the identified products (col 8, lines 20-24);
- c. Receiving a rebate request along with a transaction identifier (such as a proof of purchase)(col 8, lines 18-24);
- d. Retrieving and displaying status information pertaining to the rebate request (obvious, see discussion below);
- e. Receiving authorization of the rebate request (obvious, see discussion below);
- f. Displaying rebate information retrieved from a remote processing center including at least two disbursement options of different cash values (col 7, lines 36-43); and
- g. Receiving a selection of the disbursement option (col 7, lines 36-43).

While Small explicitly discloses that the cash value of the two options may differ, (col 8, lines 51-54), Official Notice is also taken that it is old and well known within the retail arts to offer incentives whose value varies in accordance with predetermined

criteria. Examples of these types of incentive offers are: quantity discounts where the greater number of like items bought, the greater the percentage of discount received; total purchase discounts where the higher the total purchase price, the higher the discount received; and a variety of rebate offers. In further support of this Official Notice, the examiner has previously provided an article by Guglielmo from *MacWeek*, October 24, 1989, which shows that customers who buy a Mac computer had two options: a rebate of \$150 - \$300 on other products offered by Apple Computers, or an option to return the hardware (for cash). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to give the consumer in Small options of various values. One would have been motivated to have the credit voucher larger than a cash rebate in order to entice the customer to select that offer, hence spending the rebate value back in the store.

While Small does not explicitly disclose that the rebate processing center will authorize the rebate by comparing the information received with the rebate requirements, Walker discloses a similar rebate processing method in which the rebate processing center verifies the authenticity and validity of the information and then transmits a rebate authorization (col 9, lines 20-60 and col 18, lines 11-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to authenticate the rebate request in Small and to communicate the authorization. One would have been motivated to verify the information in order to prevent awarding fraudulent rebates.

While Small does not disclose retrieving and display status information for the rebate request, Walker discloses maintaining a "status" field in the database to indicate the status of a rebate, e.g. issued, redeemed, etc. Finsterwald discloses another similar rebate processing system in which that status of the rebate request is displayed to the user (col 10, lines 21-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify the customer in Small of the current status of the rebate request, such as approved, denied, processing, etc. One would have been motivated to notify the customer of the status of the rebate in order to provide better customer service and to enable the customer to provide additional information if needed.

Claims 3 and 13: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1 and 11 above, and Small further discloses searching for the requested product (col 7, lines 52-54). It also would have been obvious to allow a user to enter search criteria when trying to locate a specific product out of the large number of products usually carried by any one merchant. One would have been motivated to utilize a search engine of some sort in this manner in order to preclude the user having to manually read through possibly thousands of items in order to identify the desired product.

Claims 4, 14, and 24: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, and 21 above. While Small also discloses that the consumer may receive a credit voucher, it is not explicitly disclosed that the consumer uses the credit voucher to purchase one or more subsequent

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products. However, Walker discloses using the credit voucher to offset the cost in a subsequent purchase (col 9, line 20-40 and col 18, lines 11-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the credit voucher issued by Small during a subsequent purchase transaction by the consumer. One would have been motivated to use the credit voucher during a subsequent transaction in order to allow the consumer to actually receive the "value" of the rebate while decreasing the store's outgoing cash flow. The Examiner notes that this is the inherent use of credit vouchers within society.

Claims 6, 16, 26, 33, and 34: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above, and Small further discloses that displaying a list of products to whose purchase the rebate may be applied is old and well known and uses the example from the 1950's and 1960's of consumers selecting products out of catalogs when redeeming trade stamp books. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display a list of products as Small's "prize redemption alternatives". One would have been motivated to display a list of products from which the consumer can select when redeeming the rebate and to also display the total price of the selected products in order to allow the consumer to ascertain whether rebate funds were available to cover an additional products.

Claims 7, 17, 27, and 35: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 6, 16, 26, and 34 above. Walker further discloses using other forms of payment, such as cash or credit cards, when the credit

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voucher does not cover the complete cost of the subsequent purchase transaction (col 9, lines 20-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a credit card in Small to cover any part of the subsequent transaction not covered by the credit voucher. One would have been motivated to use another payment method, such as a credit card, in order to allow the consumer to purchase larger (more expensive) or more numerous items during the subsequent transaction.

Claims 8, 18, 28, and 36: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above. Walker further discloses using a browser to link to a site for making a subsequent purchase (Figure 12, item 1212 and col 20, lines 2-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to direct the consumer in Small to a site where the credit voucher could be used. One would have been motivated to direct the consumer thereto in order to provide the consumer an easy and quick way to redeem the credit voucher, while at the same time providing the merchant with another sale.

Claims 9, 19, 29, and 37: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above, and Small further discloses the consumer having the options of receiving a cash rebate or a credit voucher (col 7, lines 36-43).

Claims 10, 20, 30, and 38: Small, Walker, and Finsterwald disclose a method and apparatus for processing rebates as in Claims 1, 11, 21, and 31 above, and Small

further discloses that the credit voucher comprises one of a retailer gift certificate, manufacturer credit voucher, or a credit valid for an Internet purchase (col 7, lines 36-43).

Claim 22: Small, Walker, and Finsterwald discloses an apparatus for processing rebates as in Claim 21 above, and Small further discloses matching the rebate request with the promotion (col 7, lines 56-63 and col 8, lines 20-24).

(11) Response to Argument

(a) The Appellant argues that “the Examiner cannot reject Claims 1, 3, 4, 6-11, 13, 14, 16-31, and 33-38 under 37 C.F.R. 1.78(b)”; that the requirement to cancel the claims or to maintain a clear line of demarcation between the applications “is appropriate only when the conflicting claims are patentably distinct”; and that “the Examiner has not actually made a double patenting rejection” (page 10). Initially, the Examiner notes that the rejection of these claims under Double Patenting has been changed to reflect the correct form paragraphs under Obviousness Double Patenting. Furthermore, the Examiner has maintained the same reasoning for double patenting as in the five previous Office Actions (May 2003, October 2003, February 2004, July 2004, and September 2004) and has only changed the format in which the reasoning is presented; thus, the Examiner does not believe the above is a new grounds of rejection. The Appellant’s arguments throughout the prosecution support this by repeatedly stating that they “will maintain a clear demarcation between the applications” and that the “Applicants will file a terminal disclaimer if necessary” (Response filed December 8, 2003), thus treating the original statement by the Examiner as a double patenting

rejection. The Examiner believes that the Appellant has failed to amend the present claims to distinguish them from the corresponding claims in the co-pending application; and, thus, the double patenting rejection should be upheld.

(b) The Appellant argues that none of the references disclose displaying status information for a rebate request to the customer (pages 12-16). The Examiner notes that Walker discloses maintaining status information, such as "Issued" or "Redeemed" in the database. Finsterwald also discloses maintaining status information pertaining to the customer's account and discloses retrieving, transmitting, and displaying such status information to the customer. As further noted in the Response to Argument section of the July 2005 Office Action, it is common in a wide variety of applications to maintain, retrieve, and display status information about business transactions from tracking information in package delivery systems to loan status information in loan processing systems to purchase order status information in purchasing systems, etc. Thus, the disclosure by Walker and Finsterwald of maintaining such status information would have suggested to one of ordinary skill in the art not only to maintain, but also to retrieve and display information pertaining to the status of the rebate requests in Small. The Examiner further notes that the claims merely retrieve the status information and display it to the user and do not specify that the status information excludes information on whether the rebate has been "Issued" or "Redeemed" as in Walker. Thus, the claims are viewed as broadly covering all types of status information to include the ones disclosed by Walker and Finsterwald. As to the Appellant's argument in reference to the "common knowledge" statement cited above, the Examiner notes that the Appellant

has not argued that the cited examples are not well known and, thus, has not successfully traversed them. Furthermore, this statement was made in the Response to Argument section of the Office Action and not as part of the rejection of the claims as was used to show that it is common practice within the business arts to keep your customers informed of the status of whatever type of business transaction is being conducted -- whether it pertains to a purchase request, a "rain-check", delivery of an order, processing of a loan request, etc. Such notifications have been made throughout history using such methods as verbal communication to the customer by the merchant (such as: "Yes, we received your request (order), but it won't be ready until next Tuesday"), by postal mail (such as: "Your request is being processed and will be delivered within 10-14 days"), and more recently, by interactive online messages (such as an email with a message similar to one of the other two examples above or a message that appears on the webpage informing the customer of the receipt of a request and possibly displaying a clock or numeric information counting down the remaining time for processing the request). Another example which the Appellant should recognize is the practice by the USPTO to return a postcard to the Appellant verifying the receipt and processing of submission pertaining to the present application. All of these examples show the widespread use of displaying status information to customers pertaining to their business transactions, such as orders, requests, payments, etc. Thus, since Small discloses that the customer may submit a rebate request (i.e. business transaction) via postal mail, it would have been obvious to display (i.e. inform) the status of the rebate request to the customer.

(c) The Appellant argues in reference to Claim 1 that the references do not disclose “displaying rebate information ..., where the rebate information comprises at least two disbursement options determined based on purchase information” (pages 17-18). The Appellant argues that “Small does not even consider processing of rebates” and that “allowing a customer to select between different prizes for winning a bingo game fails to teach or suggest disbursement options determined based on purchase information”. The Examiner notes that in Figure 8 Small explicitly discloses providing the customer with a rebate form (which may be printed), which includes not only spaces to list a plurality of rebate requests (items 114, 115, and 122), but also includes at least two disbursement options (item 127). This Figure is discussed in columns 8 and 9 in the reference and shows that, in contrast to the Appellant’s argument, the customer must submit the proper enclosures, such as cash register receipts. Thus, the rebate request is not merely a “winning ticket” in a bingo game, but a request for rebates based on items purchased and listed on the cash register receipt.

(d) The Appellant argues that there is no motivation to combine the references and that any such combination represents hindsight by the Examiner (pages 18-19). The Appellant argues that while Small discloses submitting rebate request forms, Walker discloses “combining gift certificates or redemption vouchers with credit card processing systems” and Finsterwald discloses “a point collecting system that may offer rewards to customers”, thus fail “to address processing of rebate requests”. The Examiner notes that processing a “redemption voucher” (Walker) or processing a “rebate request” (Small) are equivalents in the art. In either case, the processing center

receives the request from the customer, verifies the authenticity and completeness of the request, and redeems the voucher or rebate. Thus, Small and Walker both pertain to processing requests from customers. Finsterwald discloses an award point system in which the customer may request the redemption (rebate) of collected points. This reference was mainly used to show that the display of status information to the customer was known within the business arts at the time of the invention. Since Small discloses that the rebate request form maybe mailed in through the postal system, it is inherent that the rebate processing would not be instantaneous but would require a considerable amount of time (measured in days) before the rebate request processing was complete (and the rebate given to the customer). Since, like Finsterwald, Small has a need to keep the customer informed during this extended processing time, it would have been obvious to look at other business systems to ascertain methods of informing customers about the status of the business transaction (rebate/redemption request) processing. Therefore, all three references pertain to processing requests for business transactions and would have been obvious to combine the status tracking (and display) of Walker and Finsterwald with the rebate processing system of Small. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the above rejections and as noted immediately above, all three references pertain to processing requests for business transactions (redemptions of rebates, redemption vouchers, or award points) in which there is an extended amount of time between the customer submitting the request and the customer receiving the requested item/payment. Thus, it would have been obvious to add the status tracking and displaying to the system disclosed in the Small reference, especially since this was a well known problem within the arts which has been overcome in a variety of ways throughout history.

(e) The Appellant argues that the Examiner "fails to consider the claimed invention as a whole" (pages 19-20). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As discussed at length above, the Examiner has outlined how the main reference (Small) pertains to most of the claimed features. The two secondary references also pertain to and solve a similar business transaction problem (processing a redemption request from a customer). The combination of tracking and displaying the status information pertaining to such a request (which includes a "rebate transaction identifier"; e.g. the barcode on the rebate form in Small) to the customer with the invention in Small would not contradict nor alter the rest of the disclosure of Small. Nor would it render Small's system inoperable or unusable for its

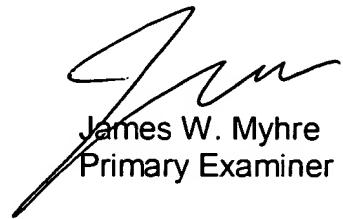
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intended purpose, but would add a well known, desirable feature to it. Thus, the references disclose the whole of the claimed invention.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JW
JWM
January 18, 2005


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Primary Examiner

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